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In re Application of : OFFICE OF PETITIONS
Bardroff et al. :
Application No. 10/505,313 : ON APPLICATION FOR
Filed: March 7, 2005 : PATENT TERM ADJUSTMENT
Attorney Docket No. F2842 US S3 :
(C018016/0180 :
Title: ANTI-AMYLOID BETA :
ANTIBODIES :

This is a decision on the "REQUEST FOR RECONSIDERATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)," filed October 16, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is two hundred ninety-one (291) days, not ninety-five (95) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

The request for review of the patent term adjustment is
Dismissed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

On August 21, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated the patent term adjustment to date is 95 days.

Applicants dispute the 198 day reduction. Applicants contend that the July 2, 2008 response to the January 28, 2008 Office action did have an omission. Further applicants contend that the supplemental response submitted on July 28, 2008 also did not contain an omission. Thus, the 198 day reduction is not warranted.

Applicants contend that the reduction 198 days should be removed because neither reply included an omission. Instead applicants contend that the responses were clarifying amendments and not required based upon an omission.

The Office has considered applicants' argument but does not find it persuasive. Applicants essentially seek to reopen prosecution after prosecution has closed. To the extent petitioner believed that the Notice of Non-Compliant amendment were mailed in error, applicants recourse was to file a petition seeking review of the Notice and or the Office actions pursuant to 37 CFR 1.181 (a)(3). Nor is the Office convinced that the final Office action acknowledges that the replies did not contain an omission. As such, the 198 day reduction for the submission of the supplemental replies on July 28, 2008 and January 16, 2009 is warranted. The time period runs from the day after the date the reply having an omission (July 3, 2008) and ending on the date that the reply or other paper correcting the omission was filed (January 16, 2009).

Further review of the record shows that an additional reduction of 90 days pursuant to 37 CFR 1.704(c)(7) is required. In response to the Restriction Requirement mailed on June 5, 2007, applicants submitted a non-compliant response on July 27, 2007. A Notice of Non-Compliant Amendment was mailed on October 18, 2007. A response to the Notice was submitted on October 25, 2007.

Pursuant to 37 CFR § 1.704(c), circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

- (7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

Thus, the reduction of 90 days for the delay from the filing of the initial response on July 28, 2007, to the filing of the response on October 25, 2007, is warranted.

In light of the fact that the 10 day reduction pursuant to 37 CFR 1.704 (c)(8) overlaps with the 90 day reduction, the 10 day reduction will be removed and the 90 day reduction will be entered.

As such the total number of days of applicants' delay at the time of the mailing of the Notice of Allowance is 379 days (90 + 19 + 65 + 198 + 5 + 2).

The total number of days of Office delay at the time of the mailing of the Notice of Allowance is 394 days.

As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

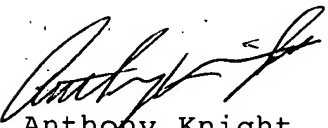
¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

In view thereof, it is concluded that the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is fifteen (15) days.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the typed name.

Anthony Knight
Director
Office of Petitions